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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,228	09/10/2003	Barbara Rae Ryan	54151.19US1	3486
34018 7590 12/29/2009 GREENBERG TRAURIG, LLP 77 WEST WACKER DRIVE SUITE 3100 CHICAGO, IL 60601-1732				
EXAMINER				
RETTA, YIHDEGA				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
12/29/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/659,228

Applicant(s)

RYAN ET AL.

Examiner

Yehdega Retta

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59 and 63-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59 and 63-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to Request for Continued Examination filed October 14, 2009. Applicant amended claim 59. Claims 59 and 63-68 are currently pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 59, 63, 66 and 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Voltmer et al. (US 7,398,225 B2).

Regarding claims 59 and 68, Voltmer teaches a distribution system to distribute a recurring cash value benefit to the consumer; *a point of sale device associated with the retail store* (located at the retail store) for accepting the distributed recurring cash value benefit (see col. 14 lines 16-67; *wherein the most-valued consumer is selected from a plurality of consumers based on at least one of the retail store's gross profit margin on the purchases made by individual ones of the plurality of consumers, and a number of trips to the retail store made by individual ones of the plurality of consumers*. Voltmer teaches a retailer may offer consumers one point for every \$10 dollars spent in the retailer store or some number of points for every fifth transaction in the store; the issuing of points either by the retailers or manufactures may be based upon any selected criteria, including a points-for-dollars ratio, a defined quantity of points per item or per transaction, some combination of these, and/or the like (see col. 11 lines 17-25, col.

12 lines 21-50). Voltmer also teaches the system may be used to compile, analyze and report data in a manner which would inform any or all network participants that for example a specific consumer (1) has made multiple purchases of particular manufacturers' products, (2) has spent Q dollars over a certain time period (3) at specific multiple retailers and (4) of the purchases made ... Voltmer further teaches system administrator may allocate rewards points to participants in the system (col. 10 lines 33-67). Voltmer also teaches that for example if a participating consumer buys a **product from a retailer for \$ 100** and if the retailer reward ratio is one reward point for each dollar ... earning 100 points (see col. 12 lines 21-50). In Voltmer a most-valued customer can be a customer who purchases a product once, but spend a predetermined amount, or one who purchases frequently (frequent shopper) or one who purchases product five times. Therefore, Voltmer teaches a most-valued customer selected from all the customers who purchases at the store, but purchased a predetermined amount or purchased a predetermined times (five times).

Regarding claims 63 and 66, Voltmer teaches the recurring cash value benefit has the form of a paycheck; distributing the benefit via Internet (see col. 9 lines 23-27, col. 14 lines 16-33).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voltmer et al. (US 7,398,225 B2) in view of Sullivan (US 6,941,279 B1).

Regarding claims 64 and 65, Voltmer teaches wherein the benefit comprises of gift certificates, rebates, credit etc., but does not explicitly teach wherein the benefit is distributed on a monthly or quarterly bases. Sullivan teaches a rebate calculated periodically, such as monthly or quarterly basis and a statement is issued to the cardholder which includes an entry for total accumulated rebate. Sullivan also teaches that the rebate amount is preferably transferred ... submitting the rebate as a two-party check which can be submitted by the customer to the investment account provider (see col. 3 lines 1-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to send the rebate statement of Voltmer monthly or yearly, as in Sullivan, if the rebate is calculated periodically, as taught in Sullivan.

Regarding claim 67, Voltmer does not teach distributing the benefit via an email message. Official notice is taken that is old and well known in the art of retail store, for stores to send email message to customer to inform them about the benefit. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the email message in Voltmer, in order to inform the customers of the reward earned, since email is the convenient way of communication.

Response to Arguments

Applicant's arguments with respect to claims 59 and 63-68 have been considered but are moot in view of the new ground(s) of rejection.

According to applicant's specification the retail store identifies a plurality of consumers to participate in the program; the retail store may select all or less than all of the consumers to

participate in the program; in some embodiments the consumers that are selected can be randomly or are most-valued consumers; a most valued consumer can be someone who appears to appreciate the retail store and has shopped regularly over many years; in some embodiment the most-valued consumers can be identified based on a least one criterion; the criterion can vary depending on the importance it has relative to the retail store;

Since frequent shoppers are consumers who make a trip to the store frequently, the frequent shoppers are most-valued consumer from those who have purchased few times (non-frequent shoppers), or those who purchased the predetermined amount or a predetermined number of times (five times) from those who didn't. As indicated above Voltmer teaches applicant's claimed limitation as indicated in claim 59.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sanchez et al. (US 2002/0174011 A1) teaches providing reward program offers based upon the partner segment to which the member is associated and the member's past transaction history.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622